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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/930,782	08/16/2001	Liqi He	DM-6864-F	3307

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EXAMINER

FORD, JOHN M

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/09/2002

41

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/930782

Applicant(s)

Ligi He ad

Examiner

J.M. Ford

Group Art Unit

1624

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 01.03.02
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

- ☐ Claim(s) 1--36 is/are pending in the application.
- ☐ Of the above claim(s) is/are withdrawn from consideration.
- ☐ Claim(s) is/are allowed.
- ☐ Claim(s) is/are rejected.
- ☐ Claim(s) is/are objected to.
- ☒ Claim(s) 1--36 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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The claims in the application are claims 1--36.

This application has been found to contain more than one invention. Therefore, restriction to one of the following distinct inventions is required:

(I) Claims 1--2 drawn to multiple methods, restrictable under MPEP 806.05(h), where the elected compounds are formula (1) where Z is N, in class 514, various subs.

(II) Claims 1--3 where Z is CR2 in formula 1, and formula 2, joins; in class 514, various subs.

If Group I or II is elected, a further election of a specific, singular, utility is required.
MPEP 806.05(h)

(III) The compounds of claims 4--11 and 15--34 where the compounds are Formula (1) where Z is N.

(IV) The compounds of claims 4--11, 12, 13 and 15--34 *of formula 1* where Z is CR2, with which formula (2) joins.

These distinct inventions have acquired separate status in the art, will support separate patents, and will require different fields of search for the respective inventions. Accordingly, restriction for examination purposes, as indicated, is considered proper; 35 U.S.C. 121; 37 CFR 1.141 and 37 CFR 1.142.

Claims 1 and claim 4 constitutes an improper joinder of inventions as it groups together species inventions that are distinct and separately classified, and will support separate patents. Ex parte Markush, 1925 C.D. 126, provided for this claim structure where there was an emergency engendered need, as the substances were "so closely related that they would not

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support a series of patents.” This is not the case here. Therefore, the instant generic claims constitute an improper joinder of inventions; Ex parte Reid, 105 U.S.P.Q. 251; In re Winnek, 73 U.S.P.Q. 225; In re Ruzicka, 66 U.S.P.Q. 226.

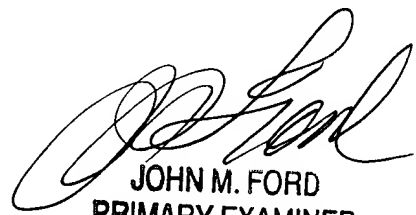
Claim 14 is not grouped, as it is dependent on a later appearing claim, i.e. claim 19.

Claims 35 and 36 were not grouped, as they are dependent on improperly dependent claims.

Applicants’ response must include a provisional election, even if the requirement be traversed see 37 CFR 1.143 and 37 CFR 1.144.

J. M. Ford:jmr

April 5, 2002


JOHN M. FORD
PRIMARY EXAMINER
GROUP - ART UNIT 1624